REMARKS

Applicants would like to thank the Examiner for the substantive review provided in this case. In the Final Office Action dated June 11, 2009, claims 1-18 and 111-114 were rejected. Claims 1, 13, 15, and 16 have been amended and claim 12 canceled in this application. Applicants respectfully submit that no new matter has been added and support for the amendments is found at least at paragraphs [0024], [0065], and [0077] of the specification as originally filed. Upon entry of this amendment, claims 1-11, 13-18, and 111-114 are pending and at issue.

DOUBLE PATENTING CLAIM REJECTIONS

Claims 1, 2, 3, and 8-10

The Examiner has provisionally rejected claims 1, 2, 3, and 8-10 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 7-10, 13-16, 41, 42, 45, 49-51, 53-59, 62, and 72-74 of co-pending U.S. Application No. 11/258,598. Claim 1 has further been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, and 19-23 of co-pending U.S. Application No. 10/493,874.

Applicants respectfully submit that because no allowable subject matter has been indicated in any of the pending applications at issue, any action by Applicants or the Examiner with regard to the filing of a terminal disclaimer is premature. Accordingly, reconsideration of the Examiner's provisional rejection of claims 1, 2, 3 and 8-10 on the ground of nonstatutory obviousness-type double patenting is respectfully requested.

Claims 1, 3, 5, 6, 7 and 12

The Examiner has rejected claims 1, 3, 5, 6, 7 and 12 on the ground of nonstatutory obviousness-type double patenting over claims 1, 2, 51, 52, 53, 56, 57, 61-67, 69 and 79 of U.S. Patent No. 6,997,863. Concurrently with this Response, Applicants have filed a Terminal Disclaimer with respect to U.S. Patent No. 6,997,863, which is commonly owned with the current application. Accordingly, Applicants respectfully request that the rejections of claims 1, 3, 5, 6, 7, and 12 on the ground of nonstatutory obviousness-type double patenting be withdrawn.

Claims 1 and 2

Claims 1 and 2 stand rejected on the ground of nonstatutory obviousness-type double patenting over claims 51-54, 57 and 58 of U.S. Patent No. 7,074,175. Concurrently with this Response, Applicants have filed a Terminal Disclaimer with respect to U.S. Patent No. 7,074,175, which is commonly owned with the current application. Accordingly, Applicants respectfully request that the rejections of claims 1 and 2 on the ground of nonstatutory obviousness-type double patenting be withdrawn.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 2, 12-15, 16, 17, 18, and 111-114

Claims 1, 2, 12-15, 16, 17, 18, and 111-114 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,167,313 to Gray et al. ("Gray") in view of U.S. Patent No. 4,979,518 Itoh et al. ("Itoh"). Applicants respectfully traverse the Examiner's rejections.

Amended independent claim 1 is nonobvious over Gray in view of Itoh because the cited references fail to teach or suggest each and every limitation of claim 1. Specifically, the combination of Gray and Itoh fails to teach or suggest, among other things, a susceptor comprising a magnetic particle, a biocompatible coating, and a ligand, wherein the ligand allows the susceptor to associate with disease material, as disclosed in amended independent claim 1. See MPEP § 2143 (stating that one of the elements of a prima facie case of obviousness under §103(a) is that the prior art references teach or suggest all of the claim limitations).

Gray discloses a method for site specific treatment comprising delivering microcapsules loaded with ferromagnetic materials to diseased tissue in a patient and exposing the magnetic material in the patient to a linear alternating magnetic field to generate hysteresis heat in the diseased tissue. (col. 2-3, lns. 66, 1-13; col. 5, lns. 47-48; col. 10, lns. 24-25). Gray fails to disclose a susceptor comprising a magnetic particle, a biocompatible coating, and a ligand, wherein the ligand allows the susceptor to associate with disease material, as disclosed in amended independent claim 1.

Itoh does not resolve the deficiencies of Gray. Itoh is directed to a body depth heating hyperthermal apparatus comprising a hollow tube insertable into a body cavity. The tube is formed of a heat generating substance, such as a mixture of iron powder and a metallic acid

salt. (abstract; col. 11, lns 14-17). Itoh fails to disclose a susceptor comprising a magnetic particle, a biocompatible coating, and a ligand, wherein the ligand allows the susceptor to associate with disease material, as disclosed in amended independent claim 1. Therefore, claim 1 is nonobvious over Gray in view of Itoh because the cited references fail to teach or suggest each and every limitation of amended independent claim 1.

For at least the reasons set forth above, amended independent claim 1 is nonobvious over Gray in view of Itoh. Because claims 2, 12-15, 16, 17, 18, and 111-114 depend from and incorporate all of the limitations of amended independent claim 1, claims 2, 12-15, 16, 17, 18, and 111-114 are nonobvious over Gray in view of Itoh. See MPEP § 2143.03 (stating that if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious). Accordingly, Applicants respectfully request withdrawal of the Examiner's rejections and reconsideration of claims 1, 2, 12-15, 16, 17, 18, and 111-114.

Claims 3, 4, 8, 9, 10, and 11

Claims 3, 4, 8, 9, 10, and 11 stand rejected as allegedly obvious over Gray in view of Itoh further in view of U.S. Patent Application Publication 2005/0151438, now U.S. Patent No. 7,239,061, to Huang et al. ("Huang"). Because claims 3, 4, 8, 9, 10, and 11 either directly or indirectly depend from and add further limitations to amended independent claim 1, such claims are allowable for at least the same reasons as amended independent claim 1. Accordingly, withdrawal of the Examiner's rejections of claims 3, 4, 8, 9, 10, and 11 and reconsideration of such claims are respectfully requested.

Claims 5, 6, and 7

Claims 5, 6, and 7 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Gray in view of Itoh further in view of U.S. Patent No. 6,477,398 to Mills ("Mills"). Because claims 5, 6, and 7 either directly or indirectly depend from and add further limitations to amended independent claim 1, claims 5, 6, and 7 are allowable for at least the same reasons. Accordingly, withdrawal of the Examiner's rejection under 35 U.S.C. § 103(a) and reconsideration of claims 5, 6, and 7 are respectfully requested.

Claim 12

Claim 12 currently stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Gray in view of Itoh further in view of U.S. Patent Application Publication 2003/0032995, now U.S. Patent No. 6,997,863, to Handy et al. ("Handy"). Claim 12 has been canceled in this application. The rejection of such claim is rendered moot in light of this amendment.

CONCLUSION

For at least the foregoing reasons, the claims at issue are patentable over the cited art. Therefore, reconsideration and allowance of all claims at issue are respectfully requested. Should the Examiner have any questions or comments, or need additional information to expedite prosecution of this application, she is invited to contact the undersigned at her convenience.

DEPOSIT ACCOUNT AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this submission, or credit any overpayment, to Deposit Account No. 50-0436.

Respectfully submitted,

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